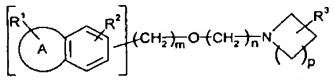
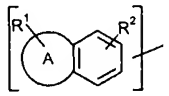
REMARKS/ARGUMENTS

The Examiner is requiring restriction to one of the following groups:

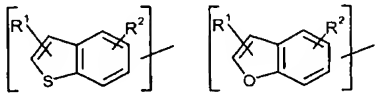
Group I: Claims 1–7 (in part), drawn to a preventative and/or remedy for retinal diseases characterized in that it comprises an alkyl derivative represented by the following formula:



wherein the portion of the compound represented by



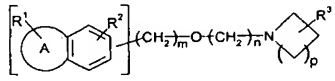
is either



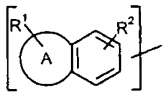
(A) (B)

and p is equal to 1.

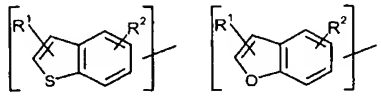
Group II: Claims 1–7 (in part), drawn to a preventative and/or remedy for retinal diseases characterized in that it comprises an alkyl derivative represented by the following formula:



wherein the portion of the compound represented by



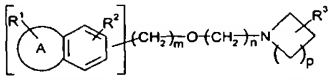
is either



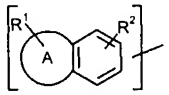
(A) (B)

and p is equal to 2.

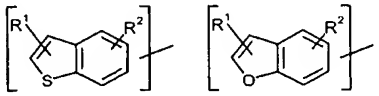
Group III: Claims 1–7 (in part), drawn to a preventative and/or remedy for retinal diseases characterized in that it comprises an alkyl derivative represented by the following formula:



wherein the portion of the compound represented by



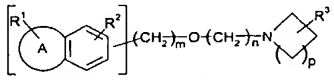
is either



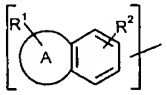
(A) (B)

and p is equal to 3.

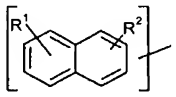
Group IV: Claims 1–7 (in part), drawn to a preventative and/or remedy for retinal diseases characterized in that it comprises an alkyl derivative represented by the following formula:



wherein the portion of the compound represented by



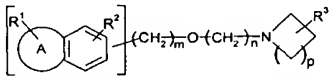
is



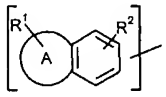
(C)

and p is equal to 1.

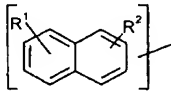
Group V: Claims 1–7 (in part), drawn to a preventative and/or remedy for retinal diseases characterized in that it comprises an alkyl derivative represented by the following formula:



wherein the portion of the compound represented by



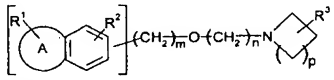
is



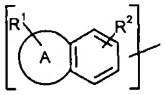
(C)

and p is equal to 2.

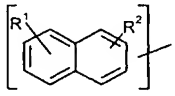
Group VI: Claims 1–7 (in part), drawn to a preventative and/or remedy for retinal diseases characterized in that it comprises an alkyl derivative represented by the following formula:



wherein the portion of the compound represented by



is



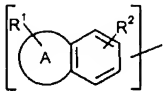
(C)

and p is equal to 3.

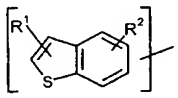
Group VII: Claims 1–7 (in part), not included in Groups I-VI.

For the elected Group, the Examiner is also requiring an election of species.

Applicants provisionally elect, for examination purposes, the specie where:



is (A)



(A) ,

R^1 and R^2 are hydrogen atoms, R^3 is OH, m is 2, n is 3, and p is 1 (readable on at least Claims 1–4). Specifically, said compound is 1-[3-(2-(1-benzothiophen-5-yl)ethoxy)propyl]-3-azetidinol.

Applicants thank Examiner Huang for the Interview Summary dated August 7, 2008, where the present Restriction Requirement is clarified to include Claims 1–7.

Restriction is only proper if the claims of the restricted groups are independent or patentably distinct and there would be a serious burden placed on the Examiner if restriction is not required (MPEP §803). Moreover, when citing lack of unity of invention in a national stage application, the Examiner has the burden of explaining why each group lacks unity with the others (MPEP § 1893.03(d)), i.e. why a single general inventive concept is nonexistent. The lack of a single inventive concept must be specifically described.

The Examiner alleges that Groups I–VII are not linked to form a single general inventive concept under PCT Rule 13.1, because, under PCT Rule 13.2, they lack the same or corresponding technical features for the following reasons: "The compound should have a common core and a common utility." The Examiner further alleges that: "... all the embodiments covered by the claims must share a common inventive utility disclosed. It is unlikely given the number of claimed compounds, that every single compound is capable of the alleged activity and therefore, it is unlikely that all or practically all of the compounds have the same effect."

Applicants submit that the Examiner has merely alleged that it is unlikely that the claimed compounds are all capable of the same activity. No evidence was presented in support of this allegation.

Furthermore, Applicants submit that the Office has not shown that a burden exists in searching all the claims of the present application. Moreover, the MPEP in §803 states as follows:

> "If the search and examination of an entire application can be made without a serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct or independent inventions."

Applicants respectfully submit that a search of all the claims would not impose a serious burden on the Office.

In regard to the Election of Species Requirement, Applicants refer to MPEP 1850 III(B), which reads in part:

> "...the requirement of a technical relationship and the same or corresponding special technical features as defined in PCT Rule 13.2, shall be considered to be met when the alternatives are of a similar nature.
>
> When the Markush grouping is for alternatives of chemical compounds, they shall be regarded as being of a similar nature where the following criteria are fulfilled:
>
> (A) All alternatives have a common property or activity; and
>
> (B)(1) A common structure is present, i.e., a significant structural element is shared by all of the alternatives; or
>
> (B)(2) In cases where the common structure cannot be the unifying criteria, all alternatives belong to a recognized class of chemical compounds in the art to which the invention pertains."

Applicants respectfully submit that the Examiner has not provided any evidence or reason showing that the claimed species do not share a common property or activity, do not have a common structure, or do not belong in a recognized class of chemical compounds. Applicants submit that the claimed species are all similar in nature and therefore a special technical feature is present. Indeed, the claimed species exhibit a common activity and share a common structural element (i.e., these compounds are active as retinal nerve disease therapeutics and are all alkyl ether derivatives represented by formula [1]).

With respect to the elected specie, Applicants respectfully submit that, should the elected specie be found allowable, the Office should expand its search to the non-elected species.

For the reasons presented above, Applicants submit that the Office has failed to meet the burden necessary in order to sustain the requirement for restriction. Applicants therefore request that the requirement for restriction be withdrawn.

Applicants respectfully submit that the above-identified application is now in condition for examination on the merits, and early notice thereof is earnestly solicited.

Respectfully Submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.

Vincent K. Shier, Ph.D.
Registration No.: 50,552

Customer Number
22850
Tel. (703) 413-3000
Fax. (703) 413-2220
(OSMMN 08/07)